

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Henry Ross Perot, et al.
Serial No.: 09/834,035
Date Filed: April 11, 2001
Group Art Unit: 3692
Confirmation No.: 1760
Examiner: Harish T. Dass
Title: *SYSTEM AND METHOD FOR MANAGING AND
TRACKING CUSTOMER INCENTIVE SECURITIES*

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the application in light of the remarks set forth below.

REMARKS

Applicants contend that the rejections of Claims 1-16, 19-23, and 48-49 contain clear legal and factual deficiencies, as described below. Applicants request a finding that the rejections of these claim are improper and that these claims are allowable.

Claims 1-12 and 48-49

The Final Office Action dated March 20, 2008 (“Office Action”) rejects Claims 1-12 and 48-49 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,787,404 issued to Fernandez-Holmann (“*Fernandez-Holmann*”) in view of U.S. Patent No. 6,157,914 issued to Seto et al. (“*Seto*”) and Raphel, “Supermarketing yesterday, today and tomorrow,” *Direct Marketing v. 57n3*, pp: 8-20, July 1994 – dialog file 15 id 00891925 (“*Raphel*”). Applicants request a finding that these rejections are improper and allowance of Claims 1-12 and 48-49.

The proposed combination fails to teach, suggest, or disclose “a transactional component that facilitates an economic transaction, wherein the economic transaction comprises a purchasing or ordering of goods or services from the company” as recited in Claim 1. In fact, *Fernandez-Holmann* teaches away from this aspect of Claim 1 by disclosing that tracking point-of-sale transactions at selected merchants for a particular consumer is “disadvantageous since particular merchants are required to be associated with the system, and the consumer may only make purchases at those merchants in order to receive the rebate into his account.” Col. 1, ll. 56-63. *Fernandez-Holmann* further discloses that “[i]t is still [a] further object of the present invention to provide such a system which gives the consumer automatic rebate-funded payments into his investment account...which is not dependent on merchants or stores becoming members of the particular rebate plan.” Col. 2, ll. 14-20. It is well established that a reference “must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02(VI); *see also KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007) (when the cited reference teaches away from combining certain elements, discovery of a successful means of combining them is more likely to be nonobvious). Because *Fernandez-Holman* teaches away from the recited elements of Claim 1, the proposed combination is improper. Accordingly, Applicants respectfully request that the rejection of Claim 1 and its dependents be withdrawn.

Claims 13-16 and 19-23

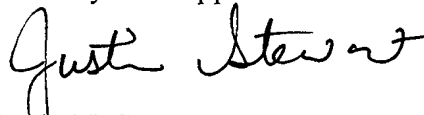
The Office Action rejects Claims 13-16 and 19-23 as being unpatentable over U.S. Patent No. 6,418,419 issued to Nieboer et al. ("*Nieboer*") in view of *Raphel* and either Martin et al., "Basic Financial Management," 5th Edition, Prentice Hall Inc., ISBN 0-13-060807-6 ("*Martin*") or Jaffe, "Shop 'n' save - or save 'n' shop?" Seattle Times, February 21, 2000 ("*Jaffe*"). Applicants request a finding that these rejections are improper and allowance of Claims 13-16 and 19-23.

The cited references fail to teach, suggest, or disclose that "a risk associated with the first form of ownership is limited to a predetermined amount, the predetermined amount being less than an initial investment of the individual in the first form of ownership" as recited in Claim 13. The Office Action relies on *Nieboer* for this element of Claim 13. Office Action, p. 7. The cited portions of *Nieboer* describe a system that provides market data to users and that receives conditional orders from users. Col. 3, ll. 15-21; col. 11, ll. 1-60; col. 19, ll. 64-67. Merely receiving conditional orders and providing market data does not teach, suggest, or disclose that "a risk associated with the first form of ownership is limited to a predetermined amount, the predetermined amount being less than an initial investment of the individual in the first form of ownership," as recited in Claim 13. *Raphel*, *Jaffe*, and *Martin* do not account for this deficiency. Therefore, the cited references do not disclose, teach, or suggest each element of Claim 13. Accordingly, the rejection of Claim 13 and its dependents is improper and should be withdrawn.

CONCLUSION

As the rejections of Claims 1-16, 19-23, and 48-49 contain clear deficiencies, Applicants respectfully request full allowance of these claims. To the extent necessary, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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Date: July 18, 2008

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